



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,028	07/10/2000	Eric Michael Lunsford	PALM-3184.US.P	9582

7590 07/02/2003

Wagner Murabito & Hao LLP
Two North Market Street Third Floor
San Jose, CA 95113

EXAMINER

MENGISTU, AMARE

ART UNIT PAPER NUMBER

2673

DATE MAILED: 07/02/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,028

Applicant(s)

LUNSFORD ET AL.

Examiner

Amare Mengistu

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 17-20, 29-32 and 42-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-16, 21-28, 33-41 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Claims 7-10,17-20,29-32 and 42-45 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made ~~without~~ traverse in Paper No. 6.

Election/Restrictions

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 11-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Matsui et al (5,493,365) (see, figs. 5-7).

4. Claims 22-25,33,35-38,46,48,49 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsui et al (5,493,365).

As to claims 23 and 36, Matsui et al (hereinafter Matsui) clearly teaches an electronic device comprising: a processor (fig.3 (45)); a bus coupled to said processor (fig.3 (the key units bus coupled to the processor)); an electronic display device coupled to a bus (fig.3, (48), col.4, lines 36-46, the display is controlled by the CPU (45), thus it is inherent that the display is coupled to the bus in order to display information); a memory (fig.3 (46,47)); a data input device (fig.3 (key units)) coupled to said bus, said

Art Unit: 2673

data input device comprising: a data input surface (fig. 5 (21); fig.6 (61); fig.7 (61a);fig.9 (71)) for detecting a gesture performed thereon by a user and for facilitating recognition of said gesture as corresponding to a particular data input, and a user removable template positioned over said data input surface for dividing said data input surface into a first data input area (fig.5 in (21) the area for (26) and also see, figs. 6,7 and 9) and a second data input area ((fig.5 in (21) the area for (24) and also see, figs. 6,7 and 9), wherein said first data input area is configured to facilitate recognition of one or more first gestures (col.5, lines 22-35), and wherein said second data input area is configured to facilitate recognition of one or more second gestures (col.5, lines 22-35).

As to claims 24,25,37,38, Matsui discloses a first gesture corresponds to a plurality of handwriting strokes (fig.5 (26) col.5, lines 22-36) and a second data input area is a keyboard (fig.5 (24), col.5, lines 22-36).

As to claims 33 and 46, Matsui also teaches that the first module is a display (fig.7 (62)) and a second module is an input device (fig.7 (63,64)).

As to claims 22 and 48, the user removable data input device includes a mechanism for automatically configuring to recognize said user removable data input device (col.4, lines 23-35) as taught by Matsui.

In regard to claims 35 and 49, Matsui discloses an electronic system having one or more communication ports (see, fig.1 (16); fig.2 (36-38,43); fig.3, the key unit communicating with CPU; fig.7 (75)).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6,14-16,21,26-28,39-41 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui et al (5,493,365) in view of Ganthier et al (5,865,546) and Sylvan et al (5,572,573).

As to claims 4-6,14-16,21,26-28,39-41 and 47, Matsui discloses a removable input device but did not explicitly disclose that the removable keys could be a shortcut key. However, one skill in the art would have recognized that the keyboard of Matsui's would have a function keys "shortcut keys" and an application programs which provides these "shortcut keys" to assist such user, whereby a function may be invoked by pressing these function keys.

Matsui has also failed to disclose the input device including a game control keys. However; Ganthier et al discloses a keyboard module and suggest that a user can replace each input device module with a different input device (see, abstract; col.2, lines 56-64). Thus, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to replace one of the input device with a game control device as taught by Ganthier into the device of Matsui because this will allow the user with more flexibility to control and minimizing the amount of input device on the keyboard.

Art Unit: 2673

Matsui has also failed to disclose that the electronic system is a PDA. The patent of Sylvan et al is cited to teach that it is well known for PDA to have both touch pad or a keyboard (see, figs.1, 2, 8 and 9).

Therefore it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use a PDA with a keyboard or touch screen as taught by Sylvan et al into the device of Matsui, since this will provide user with more compact and efficient electronic input system.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Amare Mengistu
Primary Examiner
Art Unit 2673

A.M
June 27, 2003